

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the Advisory Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the Claims, the attached Declaration of Ms. Soc Man Ho Kimura and the following remarks.

Claims Status

Claims 1-4, 6 and 10-13 are pending in this Application.

Claim 1 has been amended herein to recite the molar ratio of the amount of behenic acid to total carboxylic acids used to make the silver salt. Specifically, this ratio is recited as 34% or more. Support for the fact that behenic acid is used to make the aliphatic carboxylic acid is found in the paragraph bridging pages 29 and 30 as well as the first paragraph on page 30. Table 1 on page 98 provides support for the limitation of 54% or more since that Table clearly teaches that 54% or more of behenic acid is used to make the silver salt.

Claim 1 has also been amended herein to recite that the silver salt has a melting point of 50° or more. Support for this limitation can be found on page 30, line 13 of the Application.

Claim 12 has been amended herein because of the amendments made to Claim 1 to more particularly recite that the melting point of the silver salt is 70 to 90. Respectfully, no new matter has been added by way of these amendments as they are clearly supported in the Specification.

The Present Invention

One of the unique aspects of the present Invention is the fact that the dopant is added at nuclear formation or during grain growth. In order to emphasize this unique aspect of the present Invention, tests have been performed and are presented herein by way of a Declaration of Ms. Soc Man Ho Kimura. This Declaration demonstrates that adding the dopant during grain growth specifically produces better results than adding the dopant after grain growth. It is respectfully submitted that the art cited by Examiner does not lead one of skill in the art to an understanding that the addition of the dopant at nuclear formation or during grain growth will result in superior results to the addition of the dopant after grain growth.

Rejection

Claims 1-4, 6, 10 and 12 have been rejected as being unpatentable over a combination of Arai and Takada. Claims 11 and 13 have been rejected over a combination of Arai, Takada and Maeda.

Takada had been cited to teach the addition of tetrazaindene at various stages to include before, during or after grain formation, at or after washing, before, during or after chemical sensitization and before coating, see column 13, lines 33-36. The Examiner can clearly recognize such teaching does not direct one to any specific point in time within which to add the tetrazaindene but, rather, teaches that all are equivalent.

In order to demonstrate the fact that the addition of the tetrazaindene is critical to the present Invention, tests have been performed and are presented herein by way of a Declaration of Ms. Soc Man Ho Kimura.

In Ms. Kimura's Declaration, she attests to making Sample 7A in accordance with Arai, Example 3 wherein the tetrazaindene is added after grain formation. Sample 7A is then compared to a

second sample, Sample 7B, which is made by adding the tetrazaindene during grain formation.

It can be seen by the results in Table 7, which is attached to Ms. Kimura's Declaration, that Sample 7A had an Sb/Sa ratio outside the claims and inferior storage stability and image lasting quality compared to the present Invention, the present Invention being Sample 7B.

Given the teaching of Takada that the tetrazaindene can be added after grain formation, Sample 7A can be equated to a combination of Arai and Takada where the tetrazaindene is added after grain formation. Thus, it can be said that a combination of Arai and Takada do not inherently result in the Sb/Sa limitation of the present Invention because such a combination results in an Sb/Sa ratio outside of the claimed range.

Furthermore, the Examiner's attention is directed to Paragraph 4 of Ms. Kimura's Declaration wherein she attests to the fact that she has read Takada and is of the opinion that Takada does not direct her to any specific point of addition for the tetrazaindene.

Respectfully, it is mere hindsight to pick adding the tetrazaindene before or during grain formation rather than at any of the other times suggested in Takada. Furthermore, it is submitted that there is no teaching or suggestion in Takada that by adding the tetrazaindene either before or during grain growth that improvements in storage stability and image lasting quality will be obtained.

Respectfully, Ms. Kimura's Declaration clearly demonstrates the non obviousness of the present Invention and the fact that a combination of Arai and Takada will not inherently result in the claimed Sb/Sa ratio.

With respect to Maeda, Maeda does not add the missing elements, namely, the criticality of adding the tetrazaindene before or during grain growth and, thus, does not assist Arai and Takada rendering the claims of the present Invention.

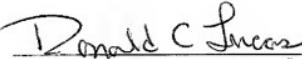
#### Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are

hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By:   
Donald C. Lucas, Reg. # 31,275  
Attorney for Applicant(s)  
475 Park Avenue South, 15<sup>th</sup> Floor  
New York, NY 10016  
Tel. # 212-661-8000

DCL/mr

Encl: Executed Declaration of Ms. Soc Man Ho Kimura signed  
on February 5, 2007